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IN THE

Supreme Court of the United States

OCTOBER TERM, 1975

No. 75-1009

DUNLOP HOLDINGS LIMITED, *Petitioner*

v.

RAM GOLF CORPORATION, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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Petitioner respectfully prays that a writ of certiorari be granted to review the judgment and opinion of the United States Court of Appeals for the Seventh Circuit, entered on October 20, 1975, in Appeal No. 74-2024 entitled *Dunlop Holdings Limited* v. *Ram Golf Corporation.*

OPINIONS BELOW

The opinion of the Court of Appeals, reprinted as Appendix A (pages 1a-8a), is reported at 524 F.2d 33 and 188 U.S.P.Q. (7th Cir. 1975). The unreported Memorandum Opinion and Order of the United States District Court for the Northern District of Illinois, Eastern Division, dated November 8, 1974, is reprinted as Appendix B (pages 9a-20a). The amendatory Minute Order of the District Court, dated November 18, 1974, is reprinted as Appendix C (page 21a).

JURISDICTION

The judgment of the United States Court of Appeals for the Seventh Circuit [Appendix A] was entered on October 20, 1975.

The jurisdiction of this Court is invoked under 28 U.S.C. §§ 1254(1) and 2101(c).

QUESTIONS PRESENTED

The Patent Act of 1952 (35 U.S.C. §§ 1 et seq) authorizes the grant of a patent for an invention unless "the invention" is anticipated in one of the several ways enumerated in § 102 or is "obvious" within the meaning of § 103. Nearly ten years ago this Court, in *Graham* v. *John Deere Co.*, 383 U.S. 1, extensively defined the concept of "obviousness" for purposes of § 103. The present case presents the following questions concerning certain of the equally important and indeed critical conditions for patentability under § 102:

1st Question

What standard should the Patent Office and the courts apply in determining whether the "invention" of a patent is anticipated within the meaning of § 102,

where prior to the critical date of the patent the only earlier work relied upon for anticipation under § 102 was deliberately carried out under conditions of utmost secrecy, and resulted in a relatively few articles of manufacture (Surlyn-covered golf balls) whose key secret (the chemical composition of the cover) was not made known to the public prior to the critical date of the patent—and even more importantly, *could not have been discovered* by the public prior to that critical date?

2nd Question

Does an article of manufacture which even the court below acknowledged to be "a noninforming public use," and which in fact prior to the critical date of the patent was a *noninformable* public use, constitute anticipation of a patent under § 102?

3rd Question

Where it is the patentee who in good faith first initiated the steps necessary to place "an invention" in the possession of the public in the sense of reproducibility at will, is the earlier work of another carried out under conditions of utmost secrecy for admittedly purely selfish reasons, and resulting only in a relatively few articles of manufacture that were not analyzed, and prior to the critical date of the patent could not have been analyzed by the public so as to reveal the key secret, sufficient to anticipate a patent under § 102?

4th Question

Having regard to the paramount Constitutional purpose of promoting the progress of science and useful arts, which one is entitled to sympathetic treatment by the Patent Office and the courts: he who in good

faith first initiated the steps necessary to place an invention in the possession of the public by filing a patent application in the regular way that fully discloses the invention, or he who did some work somewhat earlier but for purely selfish reasons worked under conditions of utmost secrecy and produced only a relatively few articles of manufacture that were not analyzed, and indeed could not have been analyzed by the public so as to reveal the key secret, prior to the critical date of the patent?

STATUTORY PROVISIONS INVOLVED

In pertinent part, the following portions of the Patent Act of 1952 are involved in this petition:

> 35 U.S.C. § 102. CONDITIONS FOR PATENTABILITY; NOVELTY AND LOSS OF RIGHT TO PATENT.
>
> "A person shall be entitled to a patent unless—
>
> "(a) the invention was known or used by others in this country . . . before the invention thereof by the applicant for patent, or
>
> "(b) the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
>
> . . . .
>
> "(g) before the applicant's invention thereof the invention was made in this country by another who had not . . . . suppressed, or concealed it . . .".

STATEMENT OF THE CASE

This is a patent infringement action brought in September of 1972 by the petitioner, Dunlop Holdings Limited ("Dunlop"), against the respondent, Ram Golf Corporation ("Ram").

In March of 1974 the district court granted Ram's motion [under F.R.C.P. 42(b)] for a separate trial of Ram's three defenses under 35 U.S.C. § 102 of alleged "prior invention," "public use" and "on sale".

Following that separate trial, the district court on November 8, 1974 entered a Memorandum Opinion and Order (App. B), including findings of fact and conclusions of law, in which it found Dunlop's patent "void" on the basis that Ram had established its §102(g) "prior invention" defense.

Following timely appeal by petitioner from the resulting dismissal of the action, the court of appeals affirmed the decision of the district court [App. A].

The patent in suit, Patent No. 3,454,280, entitled "Golf Balls Having Covers of Ethylene—Unsaturated Monocarboxylic Acid Copolymer Compositions", issued July 8, 1969.

Dunlop researchers, working in England, discovered sometime prior to February 10, 1965,[1] that certain copolymers alone or in admixture with minor amounts of compatible materials, e.g., titanium dioxide, when fabricated into a cover and molded onto a golf ball core, produce a golf ball with exceptional cut resistance. A so-called ionic form of such a copolymer derived from ethylene and methacrylic acid is made commercially by duPont, and sold under its trademark

---

[1] In view of the provisions of 35 U.S.C. § 104 applicable to inventions made abroad, petitioner is precluded from establishing an actual date of invention prior to its February 10, 1965 British application priority date. This date is referred to herein as the "critical date" of the Dunlop patent in suit.

"Surlyn". The copolymers *per se* were invented earlier by duPont, not Dunlop.

After the Dunlop invention was made and a British patent application was filed thereon on the critical date, practically every major golf ball manufacturer in the United States placed on the market at least one line of golf balls purporting to have Surlyn covers. Many millions of such golf balls have been marketed since the grant of the patent in suit. Respondent Ram was the first major golf ball manufacturer to begin making and selling (in 1967) a Surlyn-covered golf ball in the United States.

Petitioner's patent was held invalid under 35 U.S.C. § 102, based on certain West Coast activities of an individual named Leland B. ("Butch") Wagner. Butch died on October 7, 1965, and therefore long before this controversy arose.

In 1964 and for many years prior thereto, Butch was engaged in a business, Metropolitan Golf Ball, Inc., which he founded and which made golf balls for miniature golf courses and driving ranges, as well as rebuilt golf balls and novelty golf items.

Butch's earliest golf ball-related activities with Surlyn occurred in Santa Monica, California, commencing sometime after April of 1964 when DuPont first shipped Surlyn to the Los Angeles area.

In 1964, Metropolitan was making and selling golf balls for miniature golf courses having covers made from polyethylene. Metropolitan bought those covers from Mercury Plastics, Inc., a plastics molding company also located in Santa Monica.

At some undisclosed date, Butch began experimenting with a variety of different polymers in attempts (a) to produce a new golf ball having a one-piece or so-called "solid" construction and (b) to produce a new golf ball having an improved tougher cover.

Pursuant to those objectives, Butch recorded a series of experimental formulae and the results of his experiments (numbered seriatim) in an undated and unsigned formula book which he kept locked-up. He deliberately kept his formulae secret. One of his formulae, the so-called "production formula" written on a separate slip of paper dated 11/5/64, was given to his daughter Madalyn (who was closely associated with the business side of Butch's activities) for safekeeping. Of the approximately six dozens of Butch's formulations that were introduced in evidence, this separate slip of paper was the only formulation bearing a date, and had no counterpart in the formula book.

During the course of his activities, Butch called upon certain old-time friends to assist him in testing his golf balls. None were ever told or knew anything about the particular material(s) used in any particular golf ball. Some golf balls were allegedly sold to friends and business acquaintances, but no documentary evidence (e.g., invoices, cash journal entries) of any sales of Surlyn-covered golf balls *before* the critical date of the Dunlop patent was ever produced. Strangely enough, however, plenty of documentary evidence of sales *after* the critical date turned up.

Be that as it may, Butch's alleged invention was in any event very effectively "suppressed or concealed" (to quote § 102(g) of the Patent Act) before the critical date of the Dunlop patent. As uncontroverted

evidence of Butch's veritable obsession with secrecy, one may note by way of example the following testimony appearing in the record:

> *Bob Wagner*: (Butch's son) "The name Surlyn was never mentioned because my father didn't want anyone to know we were using Surlyn."
>
> "He was very secretive about it. . ."
>
> "It was a word completely obliterated from the English language."
>
> *Madalyn Brickner*: (Butch's daughter) "Everybody was instructed not to reveal that information [about Surlyn]. That was a no-no. My father's theory was if you patent a product, like if he had patented that, for two or three dollars, anyone could get a copy of the patent, change one ingredient or add one ingredient, and they've got your formula."
>
> *Stuart Elliott*: (Former Vice President and General Manager of Mercury Plastics, a concern that did custom molding for Butch) "Now, Surlyn was a dirty word with Butch. He did not mention Surlyn and I really mean this. Not even in conversation, you know."
>
> "As well as he knew me, if in a conversation with nobody around even, if I should happen to mention Surlyn, I think Butch would have just thrown a fit, you know. He was secretive with it."
>
> *Dr. Fredericks*: (An old friend and golfing companion of Butch) "Bob may have known what his father [Butch] was working with, but the exact formulae, they didn't know."
>
> *William Rhodes*: (President and Owner of Mercury Plastics) "And what else he [Butch] put in it and when he got it milled and what he did with it, he wouldn't even tell me and I was just like a son to him. . ."

In addition, the following items appearing in the record serve still further to highlight Butch's hard and fast intention to suppress or conceal his alleged invention:

1. Butch deliberately decided not to file a patent application—since that, upon issuance as a patent, would automatically result in disclosure to the public.

2. Butch instructed his business associates to deliberately mislead duPont upon inquiry by duPont into believing that the Surlyn obtained from duPont was being used for entirely non-related purposes (e.g., salt-and-pepper-shaker liners).

3. Butch used the device of a separate corporation, Golden State Distributors, of which his daughter Madalyn was a dominant figure, in a successful effort to disassociate the name "Surlyn" from his company Metropolitan Golf Ball, Inc.

4. Butch used a code known only to him to distinguish the golf balls prepared from his various formulae.

5. Butch participated in the subterfuge of filing, or causing to be filed, a trademark application in the United States Patent Office for the registration of the mark "Tuf-Flex" for his new golf balls, in the name of Golden State Distributors via his daughter Madalyn, instead of in the name of his own company Metropolitan Golf Ball, Inc.

6. Butch did not permit even his closest associates at Mercury Plastics (who injection-molded golf ball covers for Butch) to know what additional ingredients and what amounts thereof were used in his various formulations.

7. Butch did not disclose even to his own son, Bob, some of his key activities, e.g., his Topanga Canyon work with polyurethane-containing golf ball covers.

Butch apparently realized[2] that even making his golf balls available to the public would not enable anyone else to learn that Surlyn was being used in the cover—much less learn the complete formulation.

Butch's earlier work was not only "noninforming," as rightly observed by the court below, but in fact it was *noninformable*. This is clearly established by the following items of record:

(A) Terry Pocklington, an important Ram employee and one whom Ram regards as *one of the world's foremost authorities* on golf ball construction, at some date later than February 10, 1965—and even after having had the advantage of independent first-hand knowledge based on working with samples of Surlyn obtained directly from duPont and therefore knowing its properties—concluded that the golf balls placed on the market by Butch under the "Tuf-Flex" trademark (*after* Dunlop's critical date) had a cover made from some other polymeric material which he identified as "probably[3] ethylene-vinyl acetate co-

[2] Butch's belief in this respect was apparently based, at least in part, upon an incident with an experienced research chemist and close family friend, Mr. Spieth, who, at some unspecified date during Butch's experiments and at Butch's request, attempted to determine by infrared analysis (IR) something about the chemical structure of a specimen of an unidentified material Butch supplied in confidence. Spieth failed: "I never identified it as anything like Surlyn . . . I did not even know what it was . . . I'd never seen anything like that before . . . I knew some things it wasn't, that's all . . .", said Mr. Spieth during his deposition.

[3] Surlyn is an entirely different kind of copolymer. As indicated above, it is in fact an ionically cross-linked form of an ethylene-methacrylic acid copolymer.

polymer"! Approximately two years had to elapse before Mr. Pocklington could finally arrive at the conclusion that those covers were Surlyn covers.

(B) Roy H. Kinsey, *duPont's* expert on the chemistry and marketing of Surlyn, agreed that the public could not have ascertained with certainty the chemical nature of Surlyn until some time in April of 1965 (some two months *after* the critical date of the Dunlop patent) when for the first time duPont made public at a Chemical Society meeting the infrared spectograph (I.R. trace) of Surlyn which, to the chemist, is the "fingerprint" of a material such as Surlyn.

(C) The abortive attempt at analysis by Butch's research chemist friend, Mr. Spieth. See footnote 2 on p. 10, *supra*.

REASONS FOR GRANTING THE WRIT

1. This Case Provides an Excellent Vehicle for the Court To Undertake for the First Time a Much-Needed Interpretation of Section 102 of the Patent Act of 1952

The Patent Act of 1952 (35 U.S.C. §§ 1 *et seq.*) continues to be a cornerstone of the law designed for the purpose of spurring invention and economic development in the United States. Yet only on rare occasions has that Act received authoritative construction by this Court. The Court has never provided the Patent Office and lower courts with an in-depth interpretation of § 102 which outlines one of the two major tests for patentability under the Act.

This case presents an unusually good opportunity for the Court to undertake such an interpretation, with particular reference to the effect on the validity of a later patent of the earlier work of another who adopted

the most extreme measures (successfully) to draw a tight veil of secrecy over that work, and where the work itself prior to the patentee's critical date of invention resulted only in the production of a relatively few articles of manufacture that even the court below referred to as "a noninforming public use".

In *John Deere*,[4] the Court made a valuable contribution to patent jurisprudence by setting forth with clarity and precision the tests for obviousness to be applied under 35 U.S.C. § 103, which embodies the other major test for patentability under the Patent Act of 1952. The Court has never done the same with respect to the equally important provisions of § 102.[5]

Section 102 provides that a person shall be entitled to a patent unless:

> "(a) the invention was *known* or *used* by others . . . before the invention thereof by the applicant . . .; or
>
> "(b) the invention was . . . *in public use or on sale* . . . more than one year prior to the date of the application for patent . . .; or
>
> . . . .
>
> "(g) . . . the invention was *made* in this country *by another who had not . . . suppressed*, or *concealed* it [before the applicant's invention]." (Emphasis added)

These concepts underlie the all-important doctrine of "anticipation" in patent jurisprudence. Interpre-

[4] *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966).

[5] Although *U. S.* v. *Adams*, 383 U.S. 39 (1966), refers to § 102, *Adams* was decided simultaneously with *John Deere* and dealt primarily with § 103.

tations of the words "the invention", "known", "used", "in public use", "on sale" and "made by another who had not . . . suppressed or concealed it" are found in many lower court opinions. But their proper individual meanings and relationships with one another have never received the concentrated attention of this Court since their incorporation into the current Patent Act.

Moreover, the antecedents of those words in earlier patent statutes have never been considered by this Court in the present context, viz., earlier work by another deliberately shrouded in secrecy and culminating in a relatively few articles of manufacture that were not—and could not have been—analyzed by the general public prior to the patentee's critical date of invention, in the realistic sense of thereby making "the invention" available to the public for reproduction at will.

2. This Court Should Provide Clear Guidelines for the Lower Courts and the Public in Patent Cases Where Allegedly Anticipatory Subject Matter Was Not Only Deliberately Maintained in Utmost Secrecy but Also by Its Very Nature Was Not Discovered—and Could Not Have Been Discovered—by the General Public Prior to the Critical Date of the Patent

This case squarely presents the issue of the effect of earlier work on the validity of a later patent where information concerning the nature of that earlier work was deliberately withheld from the public ("suppressed or concealed") and where the work resulted in articles of manufacture (the Surlyn-covered golf balls) that not only were "a noninforming public use," as even the court below rightly recognized, but even more

importantly from the practical viewpoint, were a *non-informable* public use.

Respondent Ram did not and could not deny that prior to the critical date of petitioner's patent (February 10, 1965) the general public did not—and indeed could not—have analyzed the cover of Butch's Surlyn-covered golf balls and thereby determine its chemical composition. If there were any doubt on this point, it would be dispelled by the testimony of Roy H. Kinsey, duPont's expert on the chemistry and marketing of Surlyn, who agreed that the nature of Surlyn could not have been ascertained with certainty by the general public until sometime in April of 1965—some two months *after* petitioner's critical date—when duPont *first* publicly revealed to chemists at a Chemical Society meeting an infrared trace or spectrograph of Surlyn which, to the organic chemist, corresponds to a "fingerprint" of the material.[6]

In *Tilghman* v. *Proctor,* 102 U.S. 707 (1880), this Court referred to the earlier work of another which was asserted to be an anticipation of a later patent, in the following manner:

> "If the acids were accidently and unwittingly produced, whilst the operators were in pursuit of other and different results, without exciting attention and without its even being known what was

[6] Butch's longtime friend and golfing companion, Howard E. Spieth, a chemist experienced in infrared analysis, tried to determine the nature of the cover material *and failed.* Terry Pocklington, successively Plant Chemist, Director of Research and Development, and Plant Manager for respondent Ram, tried *and failed*—and this despite his identification by one of Ram's vice-presidents as "probably the foremost golf ball authority as far as I am concerned at that time and probably still feel the same today, available in the world."

> done *or how it had been done,* it would be *absurd* to say that this was an anticipation of Tilghman's discovery." [p. 711-712] [Emphasis added]

Here only Butch had in his possession prior to the critical date of petitioner's patent the knowledge of "how it had been done," and this knowledge was kept by Butch as a closely guarded secret.

It would be harder to imagine a more logical analogy than that existing between the accidental and unwittingly produced results of the kind referred to in *Tilghman* on the one hand and the "noninforming public use"—and indeed *noninformable* use—of the present case on the other.

The lower courts and the Patent Office badly need the guidance of this Court on this very important point.

Footnote 13 of the opinion of the court below [App. A at 8a] illustrates how the lower courts completely missed the important issue in this case. The court below remarked that it would not be unreasonable to assume that competing manufacturers of golf balls in search of a tough new material to be used as a cover might make inquiries of Butch Wagner's Surlyn supplier that would soon reveal his secret ingredient. What *escaped* the court below was the key point that this was precisely at the very heart of Butch's (successful) obsession with secrecy. Not only was Butch not about to tell members of the general public *where* he obtained the key material for his golf ball covers, but on the contrary he went to elaborate lengths (a) to buy the key material from duPont through third parties so that he and his company would have no known connection with Surlyn; (b) to fend off inquiries by duPont as

to what the key material was being used for by deliberately misinforming duPont that it was being used for other and wholly unrelated purposes (e.g., salt-and-pepper-shaker liners); and (c), shortly after the petitioner's critical date, to cause application for registration of a trademark on his golf balls to be filed in the U.S. Patent Office in the name of another company of which his daughter Madalyn was an officer.

Thus, while one cannot deny in principle the further observation of the court below (at the very end of the footnote in question) to the effect that duPont certainly had a motive to expand the market for Surlyn, nevertheless this could not have been done through any assistance that anyone received or could have expected to receive from Butch.

As in *Gayler* v. *Wilder,* 10 How. (51 U.S.) 477 (1850), the public did not learn anything about the invention from Butch's earlier work, in the sense of having the invention placed at its disposal for reproduction at will. See pp. 497-8. Having available a relatively few golf balls with covers of an unknown—and, prior to petitioner's critical date, *unknowable*—composition was certainly not equivalent to the public's having "the invention" within any reasonable meaning of § 102.

This Court should take this case with a view to settling this highly important point of patent jurisprudence.

What should have been the governing principle was aptly stated in *Kendall* v. *Winsor,* 21 How. (62 U.S.) 322 (1858). There this Court cogently observed that the "inventor" who purposely withholds his invention

from the public for his own selfish purposes is entitled to little sympathy:

> "He does not promote, and, if aided in his design, would impede, the progress of science and the useful arts" [p. 328].

While it is true that the Court in *Kendall* immediately went on to state that

> "[m]oreover, that which is once given to or is invested in the public, cannot be recalled nor taken from them",

it makes no sense whatsoever to suppose that the result of Butch's work here was to "give to" or "invest in" the public the invention here involved. The record clearly establishes that *at no time prior to petitioner's critical date* could a member of the general public have analyzed the cover composition of Butch's golf balls and thereby arrive at knowledge of how to make it. The public was not informed as to how to go about making the golf balls.

The lower courts, as well as inventors and those who invest in the development of new technology, stand badly in need of the expert guidance of this Court in the respects revealed by the facts of the present case.

In sum, the court below fell into highly prejudicial error by overlooking the Constitutional and Congressional intent of "promoting the progress of science and useful arts" (Constitution, Article I, Section 8, Clause 8). That error followed because the lower court, in effect, unjustly rewarded Butch Wagner (and those defending under him) despite his obsession or mania for preserving in utmost secrecy his work with

Surlyn-covered golf balls for as long [7] as he possibly could, as against petitioner who was the first to initiate in good faith the steps necessary to place the invention in the possession of the public within the contemplation of the Constitution and the Patent Act of 1952.

The record makes it abundantly clear that Butch Wagner and his associates would—if they could—have maintained the secret of their Surlyn-covered golf ball *forever,* rather than making their work available for the full use and enjoyment of the public in any practical sense.

This is in direct contravention of the intent of the Congress and should have negated any tendency the court below might otherwise have felt in displaying such unwarranted *tendresse* toward Butch. Butch's sole concern was to promote the progress of Butch and *not* to promote the progress of science and useful arts.

The Court should take this case in order to make a definitive ruling on this important underlying issue.

3. By Agreeing To Provide Much Needed Guidelines for Situations Involving the Difficult and Important Question Presented by the Present Case, This Court Could Go Far To Dispel the Fear in Many Quarters that the Court is "Anti-Patent"

Like the little boy in the story of "The Emperor's New Clothes", perhaps the time has come for someone to come right out and say that the view is widely held in many sectors of the community of inventors (and those associated professionally with them) that a defi-

[7] Indeed, his son Bob testified that he and his company Metropolitan did not reveal their secret to the public until 1969, some four years later.

nitely "anti-patent" attitude is displayed by the courts [8] in general, and perhaps by this Court in particular. That view, frankly, was significantly strengthened a few years ago when this Court handed down its landmark decision in *Blonder-Tongue* [9] seeming, in effect, to hold for the first time in the history of patent jurisprudence in this country that a very serious kind of estoppel was a "one-way street" working essentially always in favor of the infringer and *against* the patentee. The equitable concept of mutuality in such matters was completely thrust aside.

To grant certiorari in the present case would help to bring about the happy thought that this Court is prepared to project a relatively benevolent attitude [10] toward the Patent System that might be very much like that which must have prevailed in this country long ago—an attitude of understanding and sympathy for the Patent System bred in the apostolic age of the early days of our country when judges and counsel

[8] Unfortunately, the question of such an attitude is not simply mere rhetoric on the part of a disappointed litigant. No less an authority than a judge of the United States Court of Customs and Patent Appeals recently voiced essentially the same question. See [Associate Judge] Giles S. Rich, "How Systematic is the Patent System", 57 J. Pat. Off. Soc. 696 (November 1975) at 704: "Is the [Federal] judiciary . . . prejudiced against patents . . .?" Judge Rich will of course be recognized as one of the nation's most distinguished patent jurists, and without question the most experienced.

[9] *Blonder-Tongue Laboratories, Inc.* v. *University of Illinois Foundation et al,* 402 U.S. 313 (1971).

[10] True, the Court did make a rather complimentary remark about the Patent System as recently as 1954, but at no great "cost." This was in *Mazer* v. *Stein,* 347 U.S. 201 (1954), which was a *copyright* case. See p. 219.

breathed the air of the Constitution at a time when it still imparted everywhere its initial energy and spirit. A time, in short, when Mr. Justice Story—surely one of the greatest jurists ever to adorn the bench of this Court—could remark in passing:

> "The securing to inventors of an exclusive right to their inventions, was deemed of so much importance, as a means of promoting the progress of science and the useful arts, that the constitution has expressly delegated to Congress the power to secure such rights to them for a limited period. The inventor has, during this period, a property in his inventions; a property which is often of very great value, and of which the law intended to give him the absolute enjoyment and possession. . . . It is not lightly to be presumed, therefore, that Congress, in a class of cases placed peculiarly within its patronage and protection, involving some of the dearest and most valuable rights which society acknowledges, and the constitution itself means to favour, would institute a new and summary process, which should finally adjudge upon those rights, without a trial by jury, without a right of appeal, and without any of those guards with which, in equity suits, it has fenced round the general administration of justice." [*Ex parte Wood & Brundage*, 9 Wheat. (22 U.S.) 603 (1824) at 608].

CONCLUSION

Petitioner respectfully urges the Court to hear and resolve the important issue in this case by issuing a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit.

Respectfully submitted,

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APPENDIX

claim invention;[2] however, Wagner had not disclosed his formula to the public. The questions on appeal are (1) whether the district court's findings on the prior invention issued are supported by the record, and (2) whether the nondisclosure of the method of making an article which is in public use is the kind of concealment or suppression that avoids the bar to patentability in § 102(g).[3]

The patent covers the discovery that certain synthetic materials,[4] when fabricated by themselves (or with minor amounts of compatible materials), produce a golf ball cover with exceptional cutting resistance. An example of the material described in the patent is a duPont product named 'Surlyn.'' Golf balls made of Surlyn, with or without minor additives, infringe the claims in plaintiff's patent.

[2] 35 U.S.C. § 104 provides in part that ". . . an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title." 35 U.S.C. § 119 allows priority from the date of filing in certain foreign countries including Great Britain. Plaintiff is thus barred from establishing a date of invention by reference to its activities in Britain prior to February 10, 1965, the date of its British application.

[3] 35 U.S.C. § 102 provides:

> "A person shall be entitled to a patent unless—
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> "(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it . . . ."

[4] The parties use the term "copolymers" which we understand to refer to a kind of synthetic rubber or plastic material. The description in the patent is of

> "A golf ball comprising a core and a cover, said cover being formed of a composition comprising a copolymer of ethylene and at least one unsaturated monocarboxylic acid containing from three to eight carbon atoms, said copolymer containing up to thirty percent by weight of said acid." Patent No. 3,454,280 column 6, lines 45-50.

As noted, the date of invention claimed by plaintiff is February 10, 1965. In April of 1964, duPont was trying to find a commercial use for its Surlyn, a recently developed product. Shortly thereafter, Butch Wagner, who was in the business of selling re-covered golf balls, began to experiment with Surlyn as a golf ball cover. He first made some sample balls by hand and then, using a one-iron, determined that the material was almost impossible to cut. He obtained more Surlyn and made several dozen experimental balls, trying different combinations of additives to achieve the proper weight, color, and a texture that could easily be released from an injection molding machine. By November 5, 1964, he had developed a formula which he considered suitable for commercial production and had decided to sell Surlyn covered balls in large quantities. The date is established by a memorandum recording his formula, which Wagner wrote in his own hand and gave to his daughter for safekeeping on the occasion of her son's birthday.[5]

During the fall of 1964, Wagner provided friends and potential customers with Surlyn covered golf balls. By the end of the year he had purchased enough Surlyn to produce more than 20,000 balls, and by February of 1965 he had received orders for over 1,000 dozen Surlyn covered balls. By the end of 1965, he had ordered enough

[5] In the district court's original findings this handwritten memorandum was erroneously described as a page in Wagner's formula book, whereas it was actually a separate sheet of paper. We attach no significance to this error, which the district judge subsequently corrected, since the testimony unequivocally established the genuineness of the document. We also find no substance in appellant's objection to the district court's making this minor correction in its findings after the notice of appeal was filed. See Fed. R. Civ. P. 60(a).

Surlyn to produce more than 900,000 such balls. Without commenting further on the evidence, we note our conclusion that there is ample support in the record for the district court's findings that Wagner had discovered the use of Surlyn as a golf ball cover before November 5, 1964, had reduced the discovery to practice before February of 1965, and did not abandon the invention before his death in October of 1965.

We recognize that Wagner continued to experiment with different formulae after his decision to go into commercial production and that he encountered some problems with cracked covers. These facts do not undermine any of the district court's findings on the prior invention issue. The patent claims are broad enough to encompass any golf ball cover made principally of Surlyn, and there is no doubt that Wagner had made a large number of such golf balls and successfully placed them in public use.[6] The only novel feature of this case arises from the fact that Wagner was careful not to disclose to the public the ingredient that made his golf ball so tough.[7] For that

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[6] The evidence identifies at least three golfers who used Surlyn covered balls during the fall of 1964 for rounds of golf played at Riveria Country Club in Los Angeles. (Tr. 366-377; Fredericks Deposition, pp. 4-9; Keller Deposition, pp. 5-11) By February, 1965, two of these golfers, both of whom were favorably impressed with the play of the new ball, had placed orders with Wagner for more than 1000 dozen Surlyn covered balls; they began to distribute them commercially although they both lacked knowledge of the Surlyn content in the cover construction. (Tr. 365-377; Keller Deposition, pp. 5-11; DX 7, 8, 13, and 24-27.)

[7] In support of its contention that Wagner concealed his invention plaintiff relies on (1) the deposition of an acknowledged expert on golf ball construction who failed to discover the Surlyn content of the cover in an analysis of Wagner's ball; and (2) the secretive manner in which Wagner gave the Surlyn formula to his daughter on her son's birthday "to keep in case something ever happened to him." (Brickner Deposition, Vol. II, pp. 106-107.)

reason plaintiff argues that he "suppressed or concealed" the invention within the meaning of § 102(g).

Since 1850 it has been settled that a patentee may be entitled to credit for making a new discovery or invention even though someone else actually made the discovery before he did. *Gayler* v. *Wilder,* 51 U.S. 477. That case established the proposition that an abandoned invention will not defeat the patentability of the rediscovery of "lost art"[8] The case has also been cited for the proposition that an inventor who had merely made a secret use of his discovery should not be regarded as the first inventor. *Gilman* v. *Stearn*, 114 F.2d 28, 31 (2d Cir. 1940).

Gilman involved a patent on a machine which had previously been developed by a man named Haas; Haas had used the machine in his own factory under tight security. The output from the machine had been sold, but the public had not been given access to the machine itself. In holding that Haas was not the first inventor, Judge Hand drew a distinction between a secret use and a noninforming public use.[9] There had been only a secret

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[8] "So, too, as to the lost arts. It is well known that centuries ago discoveries were made in certain arts the fruits of which have come down to us, but the means by which the work was accomplished are at this day unknown. The knowledge has been lost for ages. Yet it would hardly be doubted, if any one now discovered an art thus lost, and it was a useful improvement, that, upon a fair construction of the act of Congress, he would be entitled to a patent. Yet he would not literally be the first and original inventor. But he would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention." 51 U.S. at 497.

See *Marconi Wireless Co.* v. *United States*, 320 U.S. 1, 35.

[9] "We are to distinguish between a public user which does not inform the art (Hall v. Macneale, 107 U.S. 90, 97, 2 S.Ct. 73, 27 L.Ed. 367) and a secret user; . . . ." 114 F.2d at 31.

use of the Haas machine and therefore he was not regarded as the first inventor.

This case certainly involves neither abandonment nor a mere secret use. For the evidence clearly demonstrates that Wagner endeavored to market his golf balls as promptly and effectively as possible. The balls themselves were in wide public use. Therefore, at best, the evidence establishes a noninforming public use of the subject matter of the invention.

If Wagner had applied for a patent more than a year after commencing the public distribution of Surlyn covered golf balls, his application would have been barred notwithstanding the noninforming character of the public use or sale. *Egbert* v. *Lippmann,* 104 U.S. 333, 336;[10] *Magnetics, Inc.* v. *Arnold Engineering Co.,* 438 F.2d 72, 74 (7th Cir. 1971). For an inventor must exercise reasonable diligence if he is to be rewarded with patent protection.[11]

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[10] "An invention may consist of a lever or spring, hidden in the running gear of a watch, or of a rachet, shaft, or cogwheel covered from view in the recesses of a machine for spinning or weaving. Nevertheless, if its inventor sells a machine of which his invention forms a part, and allows it to be used without restriction of any kind, the use is a public one."

[11] The second sentence of § 102(g) reads as follows:

"In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

A conclusion that Wagner had concealed or suppressed his invention would have to be supported by a stronger showing than a mere lack of diligence. For it is less serious to hold that the first inventor has forfeited his right to a patent monopoly than it is to hold that he has forfeited any right to use his own invention without the permission of a subsequent inventor.

> "But we must bear in mind that it was not alone to reward the inventor that the patent monopoly was granted. The public was to get its reward and have the advantage of the inventor's discovery as early as was reasonably possible. See Robinson on Patents, § 385." *Hull* v. *Davenport,* 90 F.2d 103, 105 (C.C.P.A. 1937).

The question of diligence is especially significant in cases arising out of a dispute between two applicants for a patent on the same discovery. For in such a case, when the issue is which of the two applicants is entitled to the monopoly reward, it is often appropriate to weigh the later inventor's diligence in enabling the public to obtain the benefit of the concept more heavily than the earlier date of unexploited conception. *Cf. Mason* v. *Hepburn,* 13 App. D.C. 86, 91 (1898). But in this case, although Wagner may have failed diligently to establish his own right to a patent, there was no lack of diligence in his attempt to make the benefits of his discovery available to the public. In view of his public use of the invention, albeit noninforming, we do not believe he concealed or suppressed the discovery within the meaning of § 102(g).

We recognize, as appellant argues, that portions of Judge Rich's opinion in *Palmer* v. *Dudzik,* 481 F.2d 1377 (C.C.P.A. 1973), suggests that a public use which does not disclose the inventive concept may amount to concealment within § 102(g). But that case, like *Gilman,* involved a patent on a machine; the benefits of using the machine were not made available to anyone except the inventor. Moreover, the case arose out of an interference proceeding in which the dispute was between two applicants for a patent, the earlier of the two having been less diligent than the later. In this case, Wagner was not only the first inventor, but also "the first to confer on the public the benefit of the invention," *Gayler* v. *Wilder,* 51 U.S. at 497.

There are three reasons why it is appropriate to conclude that a public use of an invention forecloses a finding of suppression or concealment even though the use does

not disclose the discovery. First, even such a use gives the public the benefit of the invention. If the new idea is permitted to have its impact in the marketplace, and thus to "promote the progress of science and useful arts,"[12] it surely has not been suppressed in an economic sense. Second, even though there may be no explicit disclosure of the inventive concept, when the article itself is freely accessible to the public at large, it is fair to presume that its secret will be uncovered by potential competitors long before the time when a patent would have expired if the inventor had made a timely application and disclosure to the Patent Office.[13] Third, the inventor is under no duty to apply for a patent; he is free to contribute his idea to the public, either voluntarily by an express disclosure, or involuntarily by a noninforming public use. In either case, although he may forfeit his entitlement to monopoly protection, it would be unjust to hold that such an election should impair his right to continue diligent efforts to market the product of his own invention.

We hold that the public use of Wagner's golf balls forecloses a finding of suppression of concealment; that holding is consistent with both the decided cases and the underlying purposes of the statute.

AFFIRMED.

A true Copy:
Teste:

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Clerk of the United States Court of Appeals for the Seventh Circuit

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[12] U.S. Const., Art. I, § 8, clause 8.

[13] In this case, for example, it is not unreasonable to assume that competing manufacturers of golf balls in search of a tough new material to be used as a cover, might make inquiries of Wagner's Surlyn supplier that would soon reveal his secret ingredient. After all, duPont certainly had a motive to expand the market for Surlyn.

APPENDIX B

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

No. 72 C 2318

DUNLOP HOLDINGS LIMITED, *Plaintiff*,

v.

RAM GOLF CORPORATION, *Defendant*.

MEMORANDUM OPINION AND ORDER

The plaintiff, hereinafter Dunlop, had charged the defendant, hereinafter Ram, with infringement of Dunlop's U. S. Patent No. 3,454,280. Earlier, I ordered a separate trial on the issues raised by Ram's three principal defenses; that separate trial having been completed and post-trial briefs having been submitted, I am now prepared to rule on those issues.

I.

Ram's three principal defenses all attack the validity of Dunlop's patent and thereby propose that the Court is without the power to grant the requested relief. Defendant's assertion of patent invalidity rests on Section 102 of the Patent Act which states, in part, as follows:

> "A person shall be entitled to a patent unless—(b) the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
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> (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it . . ."
> 35 U.S.C. § 102.

Specifically, the defendant claims that the invention was "in public use" and "on sale" in this country more than one year prior to February 2, 1965 and that the invention was made by another—a certain 'Butch' Wagner—who had not "abandoned, suppressed or concealed it" prior to February 10, 1965. The invention in question, which is the subject of Dunlop's patent, is a Surlyn-covered golf ball which has now been widely adopted by this country's golf ball industry.

II.

The law is clear that the defendant assumed heavy burdens of proof when it asserted the defenses of prior public use, *Tucker Aluminum Products, Inc.* v. *Grossman*, 312 F.2d 293 (9th Cir. 1963), *The Barbed Wire Patent*, 143 U.S. 275, 12 S.Ct. 443 (1892), *Arnel Industries Inc.* v. *Aerosol Research Co.*, 311 F.Supp. 924 (N.D. Ill. 1969), *Henry J. Kaiser Co.* v. *McLouth Steel Corp.*, 257 F.Supp. 372 (E.D. Mich. 1966); of prior sale, *Arnel Industries supra, Amerio Contract Plate Freezers, Inc.* v. *Belt-Ice Corporation*, 316 F.2d 459 (9th Cir. 1963), *Cataphote Corp.* v. *DeSoto Chemical Coatings, Inc.*, 235 F.Supp. 931 (N.D. Calif. 1964); and of prior invention, *A. J. Industries, Inc.* v. *Dayton Steel Foundry Co.*, 394 F.2d 357 (6th Cir. 1968), *Arnel Industries, supra, Copease Mfg. Co.* v. *American Photocopy Equipment Co.*, 298 F.2d 772 (7th Cir. 1961), *Potter Instrument Co., Inc.* v. *Odec Computer System, Inc.*, 370 F.Supp. 198 (D.R.I. 1974). The plaintiff has argued that the burdens have not been met, and thus that all the defenses should be rejected by the Court. The burdens may be particularly heavy since they are borne by a non-patentee. *Rex Chainbelt, Inc.* v. *Borg-Warner Corp.*, 477 F.2d 481, 491 (7th Cir. 1973). Dunlop asserts (1) the witnesses produced by Ram regarding Butch Wagner's activities were biased; (2) the decision in *The Barbed Wire Patent, supra*, precludes reliance by this Court on solely oral testimony to establish the three defenses; and (3) the record as a whole fails to support Ram's

position with respect to any one of its three defenses. In considering the defenses raised by Ram as well as the arguments asserted by Dunlop, it must be remembered that all duly-recorded patents have a presumption of validity, and any invalidation should come only after the presentation of clear and cogent evidence. 35 U.S.C. § 282; *Radio Corp. of America* v. *Radio Engineering Laboratories*, 293 U.S. 1 (1934); and *Helms Products* v. *Lake Shore Mfg. Co.* 227 F.2d 677 (7th Cir. 1955).

III.

With respect to the plaintiff's charges of bias, the fact that many of Ram's witnesses at trial may have been or may presently be engaged in making, selling or otherwise using Surlyn-covered golf balls must of course be considered by the Court in weighing the credibility of their testimony. Such statements as were made by Ram's witness Bob Wagner concerning possibile financial interests must be weighed very carefully. The presumption is that the Court in this case is in an especially good position to consider such statements since some of Ram's evidence came in the form of oral testimony during which the witnesses' demeanor was closely observed and their testimony subjected to rigorous cross-examination. In this case even the deposition witnesses were thoroughly cross-examined. Contrary to Dunlop's contentions, there was a great deal of documentary evidence presented by Ram which served to substantiate much of the oral testimony of its witnesses. It is true, however, that some of oral testimony can never be so substantiated.

I am of the opinion that the oral testimony of Ram's witnesses was not as biased as has been propsed by *Dunlop*. Of course, some of the testimony concerned events which occurred quite some time ago; but this factor goes to the matter of its evidentiary value. I observe that Ram sought to meet its heavy burden of proof with both substantial

documentary and oral evidence, and not, as Dunlop argues, with simply "oral testimony of biased witnesses."

IV.

With respect to Dunlop's argument that *The Barbed Wire Patent* case, *supra*, precludes reliance on solely oral testimony for the establishment of the three asserted defenses, I already have indicated that I have found substantial documentary evidence in the record on the issues of prior public use, prior sale and prior invention. This is not to say, however, that I am unaware of the "temptation to actual prejury," the "eagerness of interested parties to elicit testimony favorable to themselves," and the possibility that Dunlop has been "treated as the lawful prey" by Ram. *The Barbed Wire Patent* case, *supra*.

V.

Because of the nature of this case, the question resolves itself into whether or not Ram has met its burden of proof on any one of its three asserted defenses. Let me begin by reviewing the evidence that has been put forth on behalf of the prior invention defense, 35 U.S.C. 102(g). To establish the prior invention defense in this case, the defendant must have shown that before February 10, 1965, Butch Wagner made the same invention which is the subject of Dunlop's patent and did not abandon, suppress or conceal that invention. Although the defense of prior invention most commonly applies to priority disputes in interference proceedings, is also may be an appropriate defense in an infringement suit in which a patent application was never filed by the alleged prior inventor. *International Glass Co.* v. *U.S.*, 408 F.2d 395, 403 (Ct.Cl. 1969) and *Engelhardt* v. *Judd*, 369 F.2d 408, 411 (C.C.P.A. 1966).

As I have used the term and as it is employed in the statutes, an invention comprises both a conception and a

reduction to practice. *Symington Co.* v. *National Castings Co.*, 250 U.S. 383, 386 (1919); *U.S.* v. *Dubilier Condenser Corp.*, 280 U.S. 178, 188 (1933); *Jamesburg Corp* v. *Worcester Valve Co.*, 318 F. Supp. 1 (D. Mass. 1970), *affirmed* 443 F.2d 205 (1st Cir. 1971); *Spero* v. *Ringold*, 377 F.2d 652, 660 (C.C.P.A. 1967). Conception of an invention is a mental act, known only to its originator. It must be proven by evidence showing what the inventor has disclosed to others and what the disclosure meant to one of ordinary skill in the art. *Spero, supra*, 377 F.2d at 660; *Schmierer* v. *Newton*, 397 F.2d 1010, 1015 (C.C.P.A. 1968); *Boyce* v. *Anderson*, 451 F.2d 818 (9th Cir. 1971). "The conception of the invention consists in the complete performance of the mental part of the inventive act." *Townsend* v. *Smith*, 36 F.2d 292, 295 (C.C.P.A. 1929), cited with approval in *spero, supra*. Reduction to practice, on the other hand, is proven when "there is corroborated testimony that the device actually performed the function for which is was designed," *Schnick* v. *Fenn*, 277 F.2d 935, 940 (C.C.P.A. 1960), cited with approval in *Potter Instrument Co., Inc., supra*, and *Farrand Optical Co.* v. *U.S.*, 325 F.2d 328 (2nd Cir. 1963). See also *Boyce, supra*. Reduction to practice may be shown even though the device is not quite in shape to be commercially marketable. *Radio Corp. of America* v. *International Standard Electric Corp.*, 232 F.2d 726, 730 (3rd Cir. 1956) cited with approval in *Potter Instrument Co., Inc., supra*.

As I have used the terms and as they are employed in the statutes, "abandon, suppress or conceal" mean that even though an invention may be completed, no steps have been taken to make the invention publicly known, *International Glass Co., supra*, 408 F.2d at 403, and there is no reasonable explanation for the delay, *Young* v. *Dworkin*, 489 F.2d 1277, 1281 (C.C.P.A. 1974). See also *Layne-New York Co., Inc.* v. *Allied Asphalt Co., Inc.*, 363 F. Supp. 299, 305 (W.D. Pa. 1973).

Because of the aforementioned burden of proof on Ram relating to its defense of prior invention, the evidence on

Butch Wagner's conception of the notion of a Surlyn-covered golf ball and on his reduction of that conception must be "clear, satisfactory, and beyond a reasonable doubt." *The Barbed Wire Patent* case, *supra*. Although I recognize that there exist differences of opinion on the precise nature of the reasonable doubt standard in patent cases, I am of the opinion that the defendant's position in this case on the defense of prior invention has been so firmly established that is is unnecessary for me to consider the differing viewpoints. *Potter Instrument Co., Inc., supra*, 370 F. Supp. at 205.

VI.

After reviewing the entire record, I am of the opinion that Butch Wagner made the same invention, which is the subject of Dunlop's Patent No. 3,454,280, prior to February 10, 1965, and that he did not abandon, suppress or conceal it. To support this opinion, I recite the following crucial facts I find from the evidence:

1. By the early part of 1950, Butch Wagner—while President of the Metropolitan Golf Ball Company—himself had begun to experiment with the use of polyethylene as a golf ball cover material. At this time, Metropolitan was still located in Chicago. (Tr. 38, 45-46.)

2. After Metropolitan moved from Chicago to Santa Monica, California, later in 1950, Butch Wagner continued to experiment with and produce golf balls with polyethylene covers, utilizing the help of various employees of Mercury Plastics Company. (Tr. 45-46, 48-50, 58-59; Rhodes dep., 38.)

3. During the course of his experimentation with and production of golf balls after 1950, Butch Wagner maintained a so-called "Formula Book" in which he kept a record of the various mixtures or formulas

which he had used, together with a record of the results of their use. (Tr. 62-63.)

4. As of April, 1964, Surlyn was a new material which had recently been developed by the E. I. du Pont de Nemours Company, samples of which were distributed at that time with the purpose of finding commercial uses for the new material. (DX 20, 22; Kinsey dep., 291-294.)

5. The records of the du Pont company reveal that as early as April, 1964, at least 1,000 pounds of Surlyn A were shipped to du Pont's Los Angles warehouse. (DX 20.)

6. Within a short time after the Surlyn A was shipped to Los Angles, Butch Wagner obtained samples of the new material from William Rhodes of Mercury Plastics who himself obtained Surlyn A from the du Pont company. (Tr. 67, 71-72; Rhodes dep., 49-50.)

7. Shortly after obtaining samples of Surlyn A, Butch Wagner used it in his experimentation and production of golf ball covers. (Tr. 71; Rhodes dep., 50-51.)

8. After having successfully experimented with Surlyn A, Butch Wagner immediately sought to obtain large quanities of Surlyn A and did obtain such from William Rhodes. (Tr. 72-73, 76-77; Rhodes dep., 51.)

9. Upon receiving more Surlyn A, Butch Wagner—among others associated with him—further experimented with and produced golf balls covered with Surlyn A. (Tr. 74-76.)

10. The golf balls made with Surlyn A by Butch Wagner and the Metropolitan Golf Ball Company at this time—in mid 1964—contained different mixtures or formulation of materials, in that the amount of

Surlyn A and of other substances varied. (Tr. 75-76.)

11. The results of the various tests that were made on these new golf balls in mid 1964, including the test of actually playing golf with the new balls, encouraged Butch Wagner to further experiment and produce. (Tr. 76-77.)

12. The specific dates when these golf balls were made do not appear in Butch Wagner's formula book, though the various mixtures or formulations do appear therein. (DX 2.)

13. By September, 1964, 27 pounds of Surlyn half covers were produced by Mercury Plastics, resulting in the production of about 1,000 Surlyn-covered golf balls by Butch Wagner and associates. (Tr. 79-82 and 86; DX 5-6; Elliott's dep., 18-22.)

14. Some of these 1,000 surlyn-covered golf balls were placed on a certain outdoor driving range for testing, some were placed in a certain indoor golf school's driving range, some were given away by Butch and Bob Wagner, some were sold, some were played, and some were given away by William Rhodes. (Tr. 80-81, 111-113, 366-367; Rhodes dep. 57-58; Fredericks dep., 4-9; Keller dep., 5-11; DX 16.)

15. Butch Wagner recorded a formula for Surlyn-covered golf balls in his formula book on November 5, 1964. (DX 3; Tr. 82; Brickner dep., Vol. II, 106-107.)

16. The formula recorded on November 5, 1964 was one which Butch Wagner, together with his son Bob Wagner and his daughter Madalyn Brickner, decided to use in the commercial production of Surlyn-covered golf balls. (Tr. 83; Brickner dep., Vol. II,

62.) And that decision was made sometime in early November, 1964. (Tr. 83, 85-86; Brickner dep., Vol. II, 45 and 62; DX 1 and 17; Rhodes dep., 29-30, 62-63.)

17. Butch Wagner knew at the time he recorded the formula shown in DX 3, or very shortly thereafter, that the desirable properties of the golf balls produced pursuant to that formula were attributable to the use of Surlyn. (Tr. 84, 216-217; DX 1 and 17.)

18. After this decision was made to commercially produce Surlyn-covered golf balls and prior to February, 1965, at least two separate individuals placed large orders for these golf balls with Butch Wagner. (Tr. 365-371; Keller dep., 8-10; DX 7.)

19. After the decision was made to commercially produce Surlyn-covered golf balls and prior to February, 1965, at least one small order was placed with Metropolitan for the Surlyn balls and was met. (Tr. 112-113; Fredericks dep., 16-20, 28.)

20. Prior to February, 1965, some of the Surlyn-covered golf balls produced, in part, by Butch Wagner were used by several individuals at several different golf-playing areas. (Keller dep., 7-9; Fredericks dep., 6-9; Tr. 76-77, 107.)

21. A large part of the Surlyn-covered golf balls which were produced under the direction of Butch Wagner prior to February, 1965, constituted the same invention as was described by Dunlop in Patent No. 3,454,280. (PTX 1; Kinsey dep., 104-114, 349-354; PTX 19.)

22. The Surlyn-covered golf balls which were produced prior to February, 1965, exhibited the characteristics for which they were designed, including excellent

cutting resistance. (Tr. 76-77, 366; Fredericks dep., 6-9; Keller dep., 6-7.)

23. The Surlyn-covered golf balls which Butch Wagner helped to produce prior to February, 1965, were publicly known prior to February, 1965. (Tr. 76-77, 107, 112-113, 365-371; Keller dep., 8-10; Fredericks dep., 6-9, 16-20, 28.)

In light of these and other facts brought out at trial, Ram's defense of prior invention under 35 U.S.C. § 102(g) has been established, and Dunlop's Patent No. 3,454,280 therefore must be found to be void. The Court here need not establish the actual conception date of the invention in question, for it is clear that the latest possible date is November 5, 1964—a few months before Dunlop's application for a patent was filed. Nor does the Court need to establish the exact first date on which the invention in question was reduced to practice, for it is also clear that this date preceded February, 1965. Even if the reduction to practice date were found to follow the date of Dunlop's application. Dunlop's patent would under the circumstances still be found to be void. *Schmierer, supra,* 397 F.2d at 1019; *Rex Chainbelt, Inc., supra,* 477 F.2d at 487.

Having found the required conception and reduction to practice under § 102(g), I also note that the aforementioned factual findings—together with the remainder of the record—establish that Butch Wagner appreciated the nature of his invention. See, for example, *Langer* v. *Kaufman,* 465 F.2d 915, 920 (C.C.P.A. 1972). The record further establishes that the tests made of Butch Wagner's Surlyn-covered golf balls in late 1964 were "adequate to establish utility in the functional setting of the invention." *Elliott* v. *Barker,* 481 F.2d 1337, 1340 (C.C.P.A. 1973); *Potter Instrument Co., Inc., supra.*

"The courts have consistently held that an invention, though completed, is deemed abandoned, suppressed or

concealed if, within a reasonable time after completion, no steps are taken to make the invention publicly known." *International Glass Co., supra,* 408 F.2d at 403. I am of the opinion that the record in this case clearly establishes that the invention in question was publicly known prior to February, 1965. For example, see Tr. 113-114 and Fredericks dep., 6-7. The record further shows that Butch Wagner's Surlyn-covered golf balls were actually used by some individuals prior to February, 1965, and were planned for commercial production prior to February, 1965. Thus, there was no suppression of the invention. *International Glass Co., supra; Allinson Mfg. Co.* v. *Ideal Filter Co.,* 21 F.2d 22, 27 (8th Cir. 1927). See also *Dewey* v. *Lawton,* 347 F.2d 629 (C.C.P.A. 1965).

Support for this Court's position with respect to Butch Wagner's non-suppression of Surlyn-covered golf balls, at least by late 1964, can also be found by analogy from the concept of "public use" under 15 U.S.C. § 102(b). Butch Wagner's Surlyn-covered golf balls were certainly in public use by late 1964. *Electric Battery Co.* v. *Shimadzu,* 307 U.S. 5, 20 (1938); *Cali* v. *Eastern Airlines, Inc.,* 442 F. 2d 65, 70 (2nd Cir. 1971); *Magnetics, Inc.* v. *Arnold Engineering Co.,* 438 F.2d 72, 74 (7th Cir. 1971). Late 1964 is crucial because Butch Wagner used the concept of Surlyn covered golf balls by then "with a predominantly commercial intent, rather than with the primary purpose of determining whether or in what form the idea should be put into general use." *Cali, supra,* 442 F.2d at 71.

VII.

Having determined Dunlop's patent to be void under 15 U.S.C. § 102(g), there is no need for one to review Ram's defenses of "public use" and "on sale" brought pursuant to 15 U.S.C. § 102(b).

The foregoing opinion is adopted as the Court's findings of fact and conclusions of law in accordance with Rule

52(a) of the Federal Rules of Civil Procedure. Leave is granted to the defendant to file, as it sees fit, any proposed additional finding of fact or other proposed amendments, if any, to this opinion within ten (10) days. Rule 52(b) of the Federal Rules of Civil Procedure.

ENTER:

/s/ JAMES B. PARSONS
James B. Parsons
United States District Judge

Date: November 8, 1974

APPENDIX C

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

Name of Presiding Judge, Honorable James B. Parsons
Cause No. 72 C 2318 Date November 18, 1974

Title of Cause—Dunlop Holdings Limited v. Ram Golf Corporation

Brief Statement of Motion—Motion to correct memorandum opinion and order

Names and Addresses of moving counsel—
Theodore R. Scott
135 South La Salle Street
346-0338

Representing—Defendant

Names and Addresses of other counsel entitled to notice and names of parties they represent—Robert D. Weist, Two First National Plaza, Chicago, Illinois 60603.

On the motion of the defendant, it is ordered that the memorandum opinion and order heretofore entered on November 8, 1974 be and the same hereby is corrected to read as follows: Paragraph 15 on Page 7: "Butch Wagner recorded a formula for surlyn-covered golf balls and gave it to his daughter, Madalyn Brickner, for safe keeping on November 5, 1964. (DX 3; Tr. 82; Brickner dep., Vol. II, 106-107)." First unnumber Paragraph on Page 8, insert "British" before "Patent" in line 7.

JBP/

APPENDIX D

DRAMATIS PERSONAE.

For the possibly greater convenience of this Court when reading the opinions of the lower courts, the various witnesses who gave testimony in this case are as follows:

Three witnesses testified in open court, viz:

HANSBERGER, JAMES R.—Ram's Vice President of Marketing.

WAGNER, ROBERT B., SR.—Butch's son. Affiliated at various times with both Metropolitan Golf Ball Co. ("Metropolitan") and Western Golf Sales as officer.

WITTEK, KLEM—President (and later, Chairman of the Board) of Wittek Golf Range Supply Company of Chicago.

The following witnesses testified by deposition only:

BAHR, DONALD R.—Patent and Trademark Counsel for Questor Corporation, of which Spaulding is an operating division.

BRICKNER, MADALYN—Formerly Madalyn Conway. Butch's daughter. Officer of Golden State Distributors and of Metropolitan.

ELLIOTT, L. STUART—Formerly Vice President and General Manager of Mercury Plastics ("Mercury"), a concern that did custom molding for Butch.

FREDERICKS, DR. J. WYNN—Retired Director of the Department of Physical Education at U. S. C. A longtime friend and golfing companion of Butch.

HOFFMAN, BOB—Plant Superintendent of Mercury.

KELLER, WALTER E.—A golf pro, with two golf shops in Los Angeles. A longtime friend and golfing companion of Butch.

KINSEY, ROY HENRY—duPont's expert on the chemistry and marketing of "Surlyn."

LEIGHTON, CHARLES—President of C & G Plastics, a custom injection molder, since 1963. With Mercury from 1945 to 1963.

MCCLURE, DONALD J.—Vice President and Counsel for the Wilson Sporting Goods Division of Pepsico, Inc.

POCKLINGTON, TERRY—Identified by Ram's Vice President, Mr. James R. Hansberger, as "probably the foremost golf ball authority as far as I was concerned at that time and probably still feel the same today, available in the world." Mr. Pocklington was successively Plant Chemist, Director of Research and Development, and Plant Manager for Ram.

POULIN, RAYMOND J.—Sole owner of Ray's Mold Shop in Topanga, California.

RHODES, WILLIAM S.—Owner and President of Mercury.

SPARKENBAUGH, MARIAN—Personal secretary to Mr. Rhodes.

SPEITH, HOWARD E.—A chemist experienced in infrared analysis. Longtime friend and golfing companion of Butch.

TOCKER, EDWIN—A duPont patent lawyer who in 1969 made a partial investigation of the activity of Butch.

WAGNER, ROBERT B., JR.—Son of Bob, grandson of Butch. Executive and Vice President of Western Golf Sales.

WARREN, JUDY—Secretary-bookkeeper to Mr. John B. Knight, a C.P.A. and Vice President of Mercury.